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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

MATTHEWS, WILLIAM H

ART UNIT

PAPER NUMBER

3738

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DATE MAILED: 06/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/039,066

Applicant(s)

SHAMOUN, JOHN M.

Examiner

William H. Matthews (Howie)

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Claim Objections***

1. Claims 11, 15-17, 19, and 20 are objected to because of the following informalities:

Claim 11 should recite in line 2 after "questions" the phrase --and corresponding possible answers---. Furthermore, E) should be rewritten as a question. E) and M) should include "yes" and "no" as answers. I), K), and N) contain answers that should begin on a new line.

In line 1 of each of claims 15-17, "from" should be ---form---.

In line 5 of claim 19, ---to--- should be inserted after "answers".

In line 5 of claim 20, "work" should be deleted. In N), the last answer should begin on a new line. E) should be rewritten as a question. E) and M) should include "yes" and "no" as answers.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 18 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 18 is indefinite whether all or only some of the questions are to be asked (as in claim 11).

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-6,8-10,15,17,19-20 are rejected under 35 U.S.C. 102(b) as being anticipated by "Analysis of Patient Response to Preoperative Computerized Video Imaging" Thomas et al. (1989).

Thomas et al. discloses in "Patients and Methods" section a method of providing a preview image for a selected cosmetic surgery procedure including steps of asking multiple choice questions about the patient and intended surgery over a network. An image of the patient is selected and modified. Note that the network as claimed may include a network of people or computers.

6. Claims 1-6,8,10,14-17,19-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Broderick et al. US 2003/0007123.

Broderick et al. discloses in paragraphs [0051], [0054]-[0056],[0058],[0060], and [0063]-[0065] a method of providing a preview image of a cosmetic surgery procedure

for the eyes comprising asking multiple choice questions and using the answers over a network to form the image. Also disclosed is using a database of pre-existing images for the patient to select from and modify.

7. Claims 1-12,14-15,17,19-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Massengill US 2002/0064302.

Massengill discloses in abstract, paragraphs [0026], [0030]-[0034],[0048], and [0051] a method of providing a preview image of a cosmetic surgery procedure for the nose or breasts comprising asking multiple choice questions (including measurements) and using the answers over a network to form the image. Also disclosed is use of pre-existing images for the patient to select from (20 noses in paragraph [0031]).

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Massengill US 2002/0064302 as applied to claim 1 above and in further view of reasons set forth below.

Massengill discloses a method of providing a preview image for breast enhancement surgery comprising asking questions and using the answers. Regarding

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claim 13, Massengill lacks the express disclosure of asking for the specific breast measurements described in claim 13. However, in the art of cosmetic surgery, it would have been obvious, if not inherent, to ask for measurements of the patient's breasts in order to provide pre-operative and post-operative comparison for the patient when performing breast enhancement procedures.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method disclosed by Massengill by including the step of asking for specific breast measurements in order to provide pre-operative and post-operative comparison for the patient when performing breast enhancement procedures.

10. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Massengill US 2002/0064302 and in further view of Broderick et al. US 2003/0007123.

Massengill discloses in abstract, paragraphs [0026], [0030]-[0034],[0048], and [0051] a method of providing a preview image of a cosmetic surgery procedure for the breasts comprising asking multiple choice questions (including measurements) and using the answers over a network to form the image. Also disclosed is use of pre-existing images for the patient to select from (20 noses in paragraph [0031]). However, it is unclear from the disclosure whether the pre-existing images are images of the patient and modified or images taken from other people. Broderick et al. discloses in paragraph [0058] a method of providing, through a network, images from a database for patients to view and select in order to show the potential effects of a cosmetic surgery procedure.

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Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method disclosed by Massengill by including a set of images not of the prospective patient as taught by Broderick et al. in order to show the potential effects of a cosmetic surgery procedure.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. Matthews (Howie) whose telephone number is 703-305-0316. The examiner can normally be reached on Mon-Fri 7:00-4:30 (Every other Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine M. McDermott can be reached on 703-308-2111. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-2708 for regular communications and (703) 305-3590 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.



WHM

June 10, 2003

  
CORRINE McDERMOTT  
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